

REMARKS

Applicants respectfully request that the foregoing amendments be entered at least because they do not raise any issues which would require further search or consideration.

Claims 19-25 and 30-33 have been amended to remove the “means” language from those claims. Claims 26-29 have been cancelled without prejudice or disclaimer. No new matter has been added.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 19-25 and 30-34 are now pending in this application.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 19-21, 25, 29, 33 and 34 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,506,697 to Li et al. (hereafter “Li”). Claims 22-24, 26-28 and 30-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li in view of U.S. Patent No. 6,176,427 to Antognini (hereafter “Antognini”). Applicants respectfully traverse these rejections for at least the following reasons.

Independent claim 19 is directed to an image forming apparatus. Claim 19 has been amended to clarify that the apparatus includes a scanner which reads a document and provides image data on the document as first image data, and a synthesizing unit which synthesizes the first image data read by the scanner with second image data, indicative of operating conditions which determine image quality of the scanner. Neither Li nor Antognini discloses synthesizing first image data (based on reading a document with a scanner) with second image data, where the second image data is indicative of operating conditions which determine image quality of the scanner.

Li discloses a device with a page scanner 42 that reads an original document 40 containing alphanumeric text (col. 7, lines 48-50). An encoder 44 converts the alphanumeric

text into a highly compressed coded symbol 45 (col. 7, lines 50-51). The coded symbol 45 is then printed on a document 50 by a printer 46 (col. 7, lines 56-57). In addition to a content of the printed information 22a itself, the code symbol 45 may include encoded data such as application data (such as the particular software used to generate the original document text) (col. 8, lines 4-10), and data for controlling dissemination of all or portions of the content of original document (such as specifying a limited number of facsimile transmissions of the document 50 or a time limit) (col. 8, lines 19-24). The document 50 may be faxed by a transmitting facsimile machine 52 to a receiving facsimile machine 54 which prints a facsimile 56 of the original document 50, where the facsimile contains human-readable alphanumeric text 56a from the original document as well as the machine-readable facsimile symbol 56b (col. 8, lines 42-48).

While the Office Action appears to equate the code symbol 45 with the second image data as claimed, applicants submit that the code symbol 45 of Li is not indicative of operating conditions which determine image quality of a scanner which reads a document and provides image data on the read document. Li does disclose printing the code symbol 45 on a document 50 along with alphanumeric text 40a from a scanned document 40 (see col. 7, lines 46-50, col. 7, line 64 to col. 8, line 1). The code symbol 45 of Li is information, such as information regarding text, application data or data for controlling dissemination of the original document, encoded into a highly compressed symbol. Thus, while the code symbol 45 may be indicative of the alphanumeric text, or application data, or data for controlling dissemination of the original document, nowhere does Li disclose that the code symbol is indicative of operating conditions which determine image quality of the scanner which read the original document. Thus, Li fails to anticipate claim 19 for at least this reason.

Moreover, Li fails to suggest the advantages of the present invention of claim 19 where both the first and second image data, as that data is recited, are synthesized on the same sheet of paper. Specifically, the present invention of claim 19 provides important information to a user, such as a serviceperson, to aid the user in repairing or maintaining the scanner, an advantage not recognized or suggested by the device of Li. In the present invention of claim 19, operating condition information indicative of the operating conditions which determine image quality of the scanner is formed on a sheet of paper as second image data along with the first image data, which is data provided based on the scanned image. Thus, a

serviceperson may readily check the operating conditions of the scanner. This is not possible with the Li system.

Antognini does not cure the deficiencies of Li. Antognini discloses embodiments in Figures 9 and 10 with encoded digital data in a data tile format along with graphics and text on a substrate. Antognini discloses that the data tile contains “digital data relevant to the human readable information” (col. 22, lines 53-54). The Office Action appears to equate the digital encoding of Antognini with the second image data of the claims. While Antognini discloses that the data tiles contain data relevant to the graphics and text, Antognini does not disclose that the encoded digital data in the data tiles of Figures 9 and 10 is indicative of operating conditions which determine image quality of the graphics and text. Further, while Antognini discusses scanner resolution with respect to the data tiles (See col. 19, lines 14-16, col. 20, lines 25-27), the scanner resolution is with respect to the data tiles, not the scanner resolution of a scanner that scanned graphics and text to be synthesized with the data tiles. Thus, even if there were motivation (which there is not) to combine Antognini with Li, the combination would not meet all the limitations of claim 19.

The dependent claims, 20-34, all ultimately depend from claim 19 and are patentable for at least the same reasons, as well as for further patentable features recited therein. For example, claim 20 recites that the operating condition image producing unit includes a character image data producing unit which produces a character image data indicative of the operating conditions. This feature is neither disclosed nor suggested by Li or Antognini.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By Thomas G. Bilodeau

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 945-6162

Facsimile: (202) 672-5399

Pavan K. Agarwal

Registration No. 40,888

Thomas G. Bilodeau

Registration No. 43,438

Attorneys for Applicant